

REMARKS

This responds to the Office Action mailed on September 30, 2008.

Claims 1, 3-5, 7-11, 13-15, 24-28, and 30 are amended, no claims are canceled, and no claims are added; as a result, claims 1-16, 24-28, and 30 are now pending in this application.

Requirement for Information

The Examiner has requested all information related to the assignee's Ripguard technology for copy protecting DVDs or other similar technologies for copy protecting DVD's known to the inventors or assignee under 37 CFR 1.105. In response, the Applicants provide below a list of published assignee patent applications that may be related to the present patent application and thereby may be related to the assignee's Ripguard technology. The Applicants hereby make no assertion, express or implied, that the published assignee patent applications listed herein are relevant to the patentability of the present application. The Applicants are merely making a good faith effort to comply with the Examiner's request for information. The Applicants therefore consider this response to be a complete response to the request for information.

US20070053260; filed 02/04/2005; current case

US20050185926; filed 09/10/2004; cited by Examiner in a pending office action

US 20080219123; filed 03/07/2007; cited by Examiner in a pending office action

US 20050270190; filed 05/19/2005

US 20080022125; filed 07/05/2006

US 20070079050; filed 09/21/2005

US 20080222737; filed 03/07/2007

US 20080225665; filed 03/14/2007

Priority

The claim for priority based on application filed in Great Britain on February 4, 2005, Serial No. GB 0502367.6 was denied. The present application is the United States National Stage of PCT Application No. PCT/GB2005/000370 filed February 4, 2005. This PCT

Application draws priority from an application filed in Great Britain on February 19, 2004, Serial No. GB 0403719.8. A certified copy of the priority application (GB 0403719.8) is included herewith. As such, the Applicants' claim for benefit of foreign priority based on a prior application filed in a foreign country under 35 U.S.C. 119 is proper. The Applicants therefore respectfully request withdrawal of the priority claim denial.

Drawing Objections

The drawings were objected to because two different views of the embodiments shown in Figure 8 have the same figure number. In response, corrected drawings are supplied herewith. Enclosed is a complete set of drawings marked "Replacement Sheet." Figure 8 has been amended to reference the two portions of the figure as Fig. 8a and Fig. 8b. No new matter has been added. The Applicants therefore respectfully request withdrawal of the drawing objections.

Claim Objections

Claims 4 and 7 were objected to as having the following informalities: independent claim 1 recites "a corresponding data area", on page 2 line 22 of the preliminary amendment filed July 12, 2006, claim 4, which depends from independent claim 1, recites "a corresponding data area," on page 3 line 7 of the preliminary amendment filed July 12, 2006 and claim 7, which depends from independent claim 1, recites "a corresponding data area," on page 3 line 30 of the preliminary amendment filed July 12, 2006 it is unclear whether the recited claim limitations are intended to refer to the same corresponding data area.

Claims 4 and 7 have been amended herein to clarify the language noted in the claim objections.

Claim 10 was objected to as having the following informalities: independent claim 1 recites "a copy protected optical disc," on page 2 line 9 of the preliminary amendment filed July 12, 2006, independent claim 1 then references the copy protected optical disc by reciting "the optical disc," on page 2 line 9 and "the disc" on page 2 lines 14, 16, and 20, claim 10, which depends from independent claim 1, recites "a disc" on page 4 line 2 of the preliminary amendment filed July 12, 2006 it is unclear whether the recited claim limitations are intended to refer to the same optical disc.

Claims 1, 4-5, 7-10, 24, 26-28, and 30 have been amended herein to clarify the language noted in the claim objections.

Claims 11 and 13-15 were objected to as having the following informalities: independent claim 1 recites "at least one region which contains subversive data," on page 2 lines 11-12 of the preliminary amendment filed July 12, 2006, claim 11, which depends from independent claim 1, recites "at least one region of subversive data," on page 4 line 6 of the preliminary amendment filed July 12, 2006, claim 13, which depends from independent claim 1, recites "at least one region of subversive data," on page 4 line 17 of the preliminary amendment filed July 12, 2006, claim 14, which depends from independent claim 1, recites "at least one region of subversive data," on page 4 line 22 of the preliminary amendment filed July 12, 2006, claim 15, which depends from independent claim 1, recites "at least one region of subversive data," on page 4 line 27 of the preliminary amendment filed July 12, 2006, it is unclear whether the recited claim limitations are intended to refer to the same corresponding at least one region of subversive data.

Claims 11 and 13-15 have been amended herein to clarify the language noted in the claim objections.

Claims 25-27 were objected to as having the following informalities: independent claim 24 recites "a corresponding data area," on page 5 line 15 of the preliminary amendment filed July 12, 2006, claim 25, which depends from independent claim 24, recites "a corresponding data area," on page 5 line 28 of the preliminary amendment filed July 12, 2006, claim 26, which depends from independent claim 24, recites "a corresponding data area," on page 6 line 3 of the preliminary amendment filed July 12, 2006, and claim 27, which depends from independent claim 24, recites "a corresponding data area," on page 6 line 9 of the preliminary amendment filed July 12, 2006 it is unclear whether the recited claim limitations are intended to refer to the same corresponding data area.

Claims 25-27 have been amended herein to clarify the language noted in the claim objections.

Claim 30 was objected to as having the following informalities: independent claim 24 recites "a copy protected optical disc," on page 5 line 1 of the preliminary amendment filed July 12, 2006, independent claim 24 then references the copy protected optical disc by reciting "the optical disc," on page 5 lines 1-2, claim 30, which depends from independent claim 24, recites

"an optical disc" on page 6 line 21 of the preliminary amendment filed July 12, 2006 it is unclear whether the recited claim limitations are intended to refer to the same optical disc.

Claim 30 has been amended herein to clarify the language noted in the claim objections.

The Applicants therefore respectfully request withdrawal of the claim objections.

§112 Rejection of the Claims

Claims 1 and 3 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 has been amended herein to clarify the language noted in the § 112, second paragraph claim rejection. Specifically, lines 3-4 of claim 1 have been amended as follows, "wherein at least one region of the content which contains subversive data is provided within the data area..." This amendment clearly defines the content as including at least one region of subversive data. Thus, this amendment and the further amendment of claim 3 clarifies the indefiniteness noted in the § 112, second paragraph claim rejection. The Applicants therefore respectfully request withdrawal of the § 112, second paragraph claim rejection.

§101 Rejection of the Claims

Claims 24-28 and 30 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action asserts that claims 24-28 are drawn to functional descriptive material and do not fall into at least one of the four statutory classes defined by 35 U.S.C. § 101 (Office Action, pg. 8). Claim 24 has been amended herein to explicitly recite statutory elements. Specifically, claim 24 includes a processor and a memory accessible to the processor for storing content and control data." As such, the claims as currently presented are statutory under 35 U.S.C. §101. The Applicants therefore respectfully request withdrawal of the §101 rejections.

Double Patenting Rejection

Claims 1 and 24 were provisionally rejected under a non-statutory double patenting rejection, as being unpatentable over claims 1 and 18 of copending Application No. 11/715,144 in view of G@M3FR3AK, "What is Raw", posted May 1, 2001, pages 1-3. Applicant does not admit that the claims are obvious in view of claims 1 and 18 of copending U.S. Application No.

11/715,144 in view of G@M3FR3AK, "What is Raw", posted May 1, 2001, pages 1-3.

However, a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) will be timely filed to obviate these rejections.

§102 Rejection of the Claims

Claims 1-16, 24-28, and 30 were rejected under 35 U.S.C. § 102(f) as alleging the Applicants did not invent the claimed subject matter, instead derived the claimed subject matter from copending Application No. 10/939,186 (herein the '186 application).

"The mere fact that a claim recites the use of various components, each of which can be argumentatively assumed to be old, does not provide a proper basis for a rejection under 35 U.S.C. 102(f)." *Ex parte Billottet*, 192 USPQ 413, 415 (Bd. App. 1976). Derivation requires complete conception by another and communication of that conception by any means to the party charged with derivation prior to any date on which it can be shown that the one charged with derivation possessed knowledge of the invention. *Kilbey v. Thiele*, 199 USPQ 290, 294 (Bd. Pat. Inter., 1978).

In the present application, the Office Action on page 12 alleges, "The defeat of the copy protection for the optical disc is based [on] the inventive entity having specific knowledge of the copy protection technique used for protecting the optical disc. Therefore, the defeat of the copy protection for the optical disc is [a] derivation of the copy protection technique and not an original invention." Thus, the Office Action apparently alleges that mere knowledge of the copy protection technique inherently gives rise to knowledge, and complete conception of, the defeat embodiments as presently disclosed and claimed (the '967 application). However, as supported by the Declaration under 37 C.F.R. §1.132 of Jonny Boyd Reckless (declarant) provided herewith (the §132 declaration), such an assertion is completely without merit and contrary to the sworn statements of the declarant. In particular, the declarant states, "I believe that having specific knowledge of the apparatus and method for the copy protection of optical discs as disclosed and claimed in the '186 application does not inherently give rise to knowledge of the apparatus and method for the defeat of copy protection of optical discs as disclosed and claimed in the '967 application." The declarant further states, "While working with the named inventors of the '186 application on the design and development of the subject matter disclosed and

claimed in the '186 application, we did not conceive or reduce to practice any apparatus or method for the defeat of copy protection of optical discs, including the apparatus and method for the defeat of copy protection of optical discs disclosed and claimed in the '967 application." Finally, as further declared by the declarant, "I believe the subject matter disclosed and claimed in the '967 application is inventive, novel, useful, and non-obvious in view of the subject matter disclosed or claimed in the '186 application." Thus, merely having specific knowledge of a copy protection technique does not represent conception of an apparatus and method for the defeat of the copy protection technique as disclosed and claimed in the present application. Further, as supported by the §132 declaration, there was in fact no prior conception of the defeat technique by the inventors of the '186 application. Therefore, there is no 'complete conception by another' as required if the present claims were derived from the copy protection techniques conceived by the inventors of the '186 application. For these reasons, there is no derivation of the presently claimed embodiments under §102(f).

The Office Action further alleges on page 13 that, "The common inventor [i.e., Jonny Boyd Reckless)] provides a preponderance of the evidence that the method and apparatus for copy protecting an optical disc carrying content and control data in a data area conceived by the inventive entity of the copending application was communicated to the inventive entity of the present application." As noted in the Office Action, Jonny Boyd Reckless is the one and only common inventor of both the present application (the '967 application) and the '186 application. Thus, the declarant of the §132 declaration is in the unique position of knowing the full scope of the subject matter conceived and claimed in both the '967 application and the '186 application. As supported by the §132 declaration and the arguments set forth above, there was in fact no conception of the defeat technique by the inventors of the '186 application. Therefore, there was no 'complete conception by another'. Because there was no 'complete conception by another', there could not have been any communication of any conception to any of the inventors of the present application. Thus, there is no derivation of the presently claimed embodiments under §102(f).

Therefore, for the reasons set forth above, the Applicant respectfully request withdrawal of the §102(f) rejection.

CONCLUSION

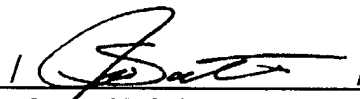
Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 406-4855 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

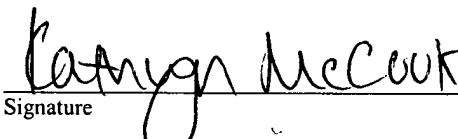
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By 
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CERTIFICATE UNDER 37 CFR 1.10: The undersigned hereby certifies that this correspondence is being filed with sufficient postage via Express Mail, and is addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 30th day of March, 2009.
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